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| SCHIFF HARDIN, LLP | | | EXAMINER | |
| PATENT DEPARTMENT | | | PHAM, ANDY L | |
| 6600 SEARS TOWER | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--------------------------------------|
| Office Action Summary | Application No. 10/525,302 | Applicant(s) SIPPEL ET AL. |
| | Examiner ANDY L. PHAM | Art Unit 2854 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 21 May 2008.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 13-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 13-26 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's arguments, see Pages 1-2, filed 5/21/2008, with respect to the Restriction Requirement filed on 4/22/2008 have been fully considered and are persuasive. The Restriction Requirement has been withdrawn.

Claim Objections

2. Claim 22 is objected to because of the following informalities:

Line 3 of Claim 22 recites "said printing modules" but lacks antecedent basis. However, "a print module" has been defined. The "said printing modules" will be treated as "a print module" for the remainder of this Office Action.

Line 11 of Claim 22 recites "a module" but also lacks antecedent basis. Since "a print module" has been defined already, the "a module" will be treated as "the print module" as defined earlier.

Claim 24 is objected to because of the following informalities:

Line 12 of Claim 24 recites a "*" after the word "not." This will be treated as a typo.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Shimomura et al. (US 5,999,757).

Shimomura et al. teach a method for automatically eliminating an error during operation of an electrographic printing or copying device (**Abstract**).

The method of eliminating an error upon which the applicant is claiming occurs ONLY "upon the occurrence of an error." Assuming no error occurs, no steps of the method are taken to attempt to eliminate error during operation of the device.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Regarding claim 13, the method of eliminating an error upon which the applicant is claiming occurs ONLY “upon the occurrence of an error.” Assuming now an error does occur, the steps of the method are then taken to attempt to eliminate error during operation of the device.

8. Claims 13-18 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimomura et al. USP 5,999,757 in view of Sadler USP 6,408,407.

Regarding claims 13, 21, 22, 23, and 24, Shimomura et al. teach an electrographic printing or copying device and method, comprising:

- an input for printable media to be printed (units **8**);
- a print module including at least one printable media transport path, said print module printing on said printable media (units **8**);
- an output connected to said printing module to receive printed printable media (units **8**);

- a controller connected to said input and to said print module and to said output to detect an occurrence of an error and determine whether the error can be corrected automatically, said controller switching to error correcting mode in case the error can be corrected, otherwise ending the main error-correcting mode (sequence formulation section **23**).

Shimomura et al. does not teach explicitly testing components in a direction opposite to a media flow path including, commanding the print module to correct an error, said command including instructing the first module to move the printable media in the media transport direction, transmitting a status signal indicating the error has

been corrected if the correction is successful or if no error is present, otherwise transmitting a status signal indicating that the error is not corrected, and if the error has not been corrected by the first module, transmitting a command to correct the error to a second module, the second module preceding the first module in the media transport direction. However, it would be known to someone of ordinary skill in the art to test all components in sequence, regardless of the sequence or order (Col 5-6, lines 65-67 and 1-9).

Shimomura et al. does not teach in case the status signal that the error has not been corrected is transmitted, determining whether operation of the printing or copying device can proceed without the module having the error, then transmitting a status signal indicating operation possible, otherwise transmitting a status signal indicating error not corrected; and

after all affected modules have been queried, ending error-correcting mode if an occurrence of a status signal indicating that an error is not corrected and at least one module persists and reporting an error in the error module, otherwise ending the error-correcting mode and transmitting a status signal indicating error corrected.

Sadler teaches in case the status signal that the error has not been corrected is transmitted, determining whether operation of the device can proceed without the module having the error, then transmitting a status signal indicating operation possible, otherwise transmitting a status signal indicating error not corrected (Col 4 and 5; lines 66-67 and 1-6); and

after all affected modules have been queried, ending error-correcting mode if an occurrence of a status signal indicating that an error is not corrected and at least one module persists and reporting an error in the error module, otherwise ending the error-correcting mode and transmitting a status signal indicating error corrected (**Abstract**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the error delegating processing system as taught by Sadler in the sheet transportation device of Shimomura et al. for the purpose of transmitting status signals indicating errors.

Regarding claim 14, Sadler teaches in case a module indicates a status signal showing that an error has not been corrected, determining whether the module can be bypassed; and

If the module can be bypassed, then transmitting a status signal indicating operation possible, otherwise transmitting a status signal indicating error not corrected (Col 4 and 5; lines 66-67 and 1-6).

Regarding claim 15, Shimomura et al. teach controlling error correction by a dedicated control unit (sequence formulation section **23**) of a querying component that is controlled by a main control unit (evaluation section **22**) of the printing or copying device.

Regarding claim 16, Shimomura et al. teach separately testing the plurality of consecutively arranged components of the printing or copying device (Col 4, lines 26-35).

Regarding claim 17, Shimomura et al. does not teach explicitly testing components in a direction opposite to a media flow path. However, it would be known to someone of ordinary skill in the art to test all components in sequence regardless of what sequence or order (Col 5-6, lines 65-67 and 1-9).

Regarding claim 18, Shimomura et al. teach wherein said components of the printing or copying device include input components and output components for printable media (Col 4, lines 21-25).

Regarding claim 20, Shimomura et al. teach wherein said modules are transport modules for transporting printable media (Col 4, lines 21-25) and a correction is undertaken to correct a paper jam of at least one sheet of the printable media (Col 5, lines 61-67).

Regarding claim 25, Shimomura et al. teach wherein the error is a media transport error, and said command to correct the error is a command to the module to operate media transport mechanisms in the media transport direction (See Col 5, lines 21-30).

Regarding claim 26, Shimomura et al. teach wherein said media transport error is a paper jam, and said command to correct the error is a command to move paper along the media transport path in the media transport direction (See Col 5, lines 40-45).

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimomura et al. USP 5,999,757 in view of Sadler USP 6,408,407 as applied to claims 13 and 18 above, and further in view of Boehmer et al. USP 6,317,581.

The combined teachings of Shimomura et al. and Sadler teach the limitations of claim 18 as applied for reasons above.

Shimomura et al. and Sadler do not teach wherein print components are disposed in multiple groups between said input components and said output components and further comprising at least one switch module so that a plurality of transport paths are defined for printable media.

Boehmer et al. teaches wherein print components are disposed in multiple groups between said input components and said output components and further comprising at least one switch module (second shunt **W2** and third shunt **W3**) so that a plurality of transport paths are defined for printable media (adjoining transport paths **44, 48, 52**; Col 4, lines 19-22)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a plurality of transport paths for printable media as taught by Boehmer et al. for the use in the sheet transporting device of Shimomura et al. and Sadler to redirect printable media to another transport path during a paper jam.

Response to Arguments

10. Applicant's arguments filed 1/31/2008 have been fully considered but they are not persuasive.

In response to the arguments regarding 35 USC § 102(b), the Shimomura et al. reference reads on the claimed invention when no error occurs. Therefore, the method

of correcting errors in sequence in a direction opposite the paper transport direction does not apply. This step only occurs "upon the occurrence of an error."

In response to the arguments regarding 35 USC § 103(a), the Sadler reference is not relied upon to teach or suggest to query modules in a reverse direction to media flow, therefore this argument is moot.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Shimomura et al. reference is relied upon to teach clearing of paper jams along a media transport path of a printer or copier. Shimomura et al. fails to teach transmitting status signals indicating errors. Sadler is therefore relied upon to teach the transmission of status signals indicating errors.

In response to applicant's argument regarding no teaching to test the operation of the units in reverse flow order, Shimomura et al. teach to test all components in sequence. Although Shimomura et al. is silent as to which order these components are tested, all of the components are tested one by one in a sequential order. Testing the operation of units in reverse flow order does not appear to change the expected outcome and does not appear to be advantageous. Therefore the order in which the

units are tested would have been a simple matter of preference to those skilled in the art.

In response to the Boehmer reference not teaching or suggesting the error correction method as disclosed and taught, the Boehmer reference is not relied upon solely to teach this method but rather in combination with the other references. Boehmer is used to teach a plurality of transport paths for printable media.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDY L. PHAM whose telephone number is (571)270-1877. The examiner can normally be reached on Monday-Friday 7:30-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALP

/Ren L Yan/
Primary Examiner, Art Unit 2854